

Atty Docket No.: 532212000623

Inventor: Thomas L. CANTOR

Application No.: 10/617,489

Filing Date: July 10, 2003

Title: METHODS, KITS AND ANTIBODIES FOR DETECTING PARATHYROID
HORMONE

Documents Filed:

Transmittal (1 page)

Fee Transmittal (1 page + duplicate)

Supplemental Information Disclosure Statement (3 pages)

Form PTO/SB/08a/b (6 pages + duplicate)

170 References in 3 separate boxes

(Box 1 contains original transmittals; Boxes 2 & 3 contain copies of all transmittals)

Via: Express Mail: Airbill No. EV 513 164 718 US (BOX 1); EV 513 164 704 US (BOX 2);
EV 513 164 695 US (BOX 3)

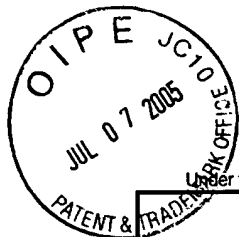
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Date: July 7, 2005

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07-08-05

12W/15

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| | | | |
|---|----|------------------------|------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 10/617,489 |
| | | Filing Date | July 10, 2003 |
| | | First Named Inventor | Thomas L. CANTOR |
| | | Art Unit | 1641 |
| | | Examiner Name | C. Cheu |
| Total Number of Pages in This Submission | 18 | Attorney Docket Number | 532212000623 |

ENCLOSURES (Check all that apply)

| | | |
|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form (1 page + duplicate) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (3 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Form PTO/SB/08a/b (6 pages + duplicate) 170 References Return Receipt Postcard |
| Remarks Customer No. 25225 | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-------------------------|----------|--------|
| Firm Name | MORRISON & FOERSTER LLP | | |
| Signature | | | |
| Printed name | Peng Chen | | |
| Date | July 7, 2005 | Reg. No. | 43,543 |

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 513 164 718 US (BOX 1); EV 513 164 704 US (BOX 2); EV 513 164 695 US (BOX 3), addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: July 7, 2005

Signature:

(Rhonda L. Mason)



PTO/SB/17 (12-04v2)

Approved for use through 7/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| | | | |
|---|--|--------------------------|------------------|
| FEE TRANSMITTAL For FY 2005 | | Complete if Known | |
| | | Application Number | 10/617,489 |
| | | Filing Date | July 10, 2003 |
| | | First Named Inventor | Thomas L. CANTOR |
| | | Examiner Name | C. CHEU |
| <input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27 | | Art Unit | 1641 |
| TOTAL AMOUNT OF PAYMENT | | (\$) | 180.00 |
| | | Attorney Docket No. | 532212000623 |

METHOD OF PAYMENT (check all that apply)

| | | | | |
|---|---|--------------------------------------|--|---|
| <input type="checkbox"/> Check | <input type="checkbox"/> Credit Card | <input type="checkbox"/> Money Order | <input type="checkbox"/> None | <input type="checkbox"/> Other (please identify): _____ |
| <input checked="" type="checkbox"/> Deposit Account | Deposit Account Number: <u>03-1952</u> | | Deposit Account Name: <u>Morrison & Foerster LLP</u> | |
| For the above-identified deposit account, the Director is hereby authorized to: (check all that apply) | | | | |
| <input checked="" type="checkbox"/> Charge fee(s) indicated below | <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee | | | |
| <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 | <input checked="" type="checkbox"/> Credit any overpayments | | | |

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| | | | | |
|---------------------|---------------------|-----------------|----------------------|--------------------------------------|
| <u>Total Claims</u> | <u>Extra Claims</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> | <u>Multiple Dependent Claims</u> |
| 80 | - 80 = | x | = | <u>Fee (\$)</u> <u>Fee Paid (\$)</u> |

| | | | |
|----------------------|---------------------|-----------------|----------------------|
| <u>Indep. Claims</u> | <u>Extra Claims</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> |
| 4 | - 4 = | x | = |

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| | | | | |
|---------------------|---------------------|---|--------------------------------|----------------------|
| <u>Total Sheets</u> | <u>Extra Sheets</u> | <u>Number of each additional 50 or fraction thereof</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> |
| | - 100 = | /50 | (round up to a whole number) x | = |

4. OTHER FEE(S)

| | |
|---|-----------------------|
| Non-English Specification, \$130 fee (no small entity discount) | <u>Fees Paid (\$)</u> |
| Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement | 180.00 |

SUBMITTED BY

| | | | | | |
|-------------------|-----------|-----------------------------------|--------------|-----------|----------------|
| Signature | | Registration No. (Attorney/Agent) | 43,543 | Telephone | (858) 720-5117 |
| Name (Print/Type) | Peng Chen | Date | July 7, 2005 | | |

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 513 164 718 US (BOX 1); EV 513 164 704 US (BOX 2); EV 513 164 695 US (BOX 3), addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: July 7, 2005

Signature: Rhonda L. Mason

(Rhonda L. Mason)

Patent

Docket No. 532212000623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicant submits for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of non-patent literature documents numbered 3, 4, 5, 6, 10, 11, 12, 13, 17, 18, 20, 23 and 24-181 are submitted herewith. The remaining documents listed on the attached Form PTO/SB/08a/b were disclosed and submitted in previously filed Information Disclosure Statements for this matter. The Examiner is requested to make these documents of record.

Document numbers 1-23 listed on the attached Form PTO/SB/08a/b were recently disclosed by defendants Immutopics, Inc. in currently pending civil litigation: *Scantibodies Laboratory, Inc. v. Immutopics, Inc. et al.*, U.S.D.C. Case No. CV 04-8871 GPS (MANx).

sd-265419

Document numbers 24-181 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, Case No. 02 CV 0046 B (LAB).

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)


Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

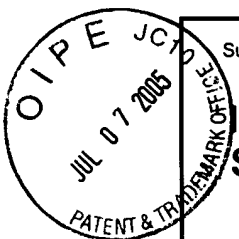
The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: July 7, 2005

Respectfully submitted,

By 
Peng Chen
Registration No.: 43,543
MORRISON & FOERSTER LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
(858) 720-5117



Substitute for form 1449/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet 1 of 6

Complete if Known

| | |
|------------------------|------------------|
| Application Number | 10/617,489 |
| Filing Date | July 10, 2003 |
| First Named Inventor | Thomas L. CANTOR |
| Art Unit | 1641 |
| Examiner Name | C. Cheu |
| Attorney Docket Number | 532212000623 |

U.S. PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|-----------------------|--|--------------------------------|--|---|
| | | Number-Kind Code ² (if known) | | | |
| | 1. | US-5,656,455 | 08-12-1997 | Wood et al. | |
| | 2. | US-6,030,790 | 02-29-2000 | Adermann et al. | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
|--------------------|-----------------------|---|--------------------------------|--|---|----------------|
| | | Country Code ³ -Number ⁴ -Kind Code ⁵ (if known) | | | | |
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*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
|--------------------|-----------------------|---|----------------|
| | 3. | Certificate of Correction pertaining to inventorship for U.S. Patent No. 6,030,790, dated August 6, 2002 | |
| | 4. | Certificate of Correction pertaining to text for U.S. Patent No. 6,030,790, dated August 27, 2002 | |
| | 5. | DELMAS et al., Molecular Immunology (1985) 22:675-679 | |
| | 6. | DESPLAN et al., The Lancet (1977) July:198-199 | |
| | 7. | FISCHER et al., The Journal of Clinical Investigation (1974) 54:1382-1394 | |
| | 8. | GAO et al., Clinica Chimica Acta (1996) 245:39-59 | |
| | 9. | GAO et al., J. Bone Mineral Res. (2001) 16:605-614 | |
| | 10. | HABENER and POTTS, Endocrinology (1979) 105:115-119 | |
| | 11. | HABENER et al., Endocrine Research Communications (1974) 1:1-17 | |
| | 12. | HANLEY and WELLINGS, Journal of Immunoassay (1985) 6:245-259 | |
| | 13. | HENDY et al., Proceedings of the Society for Endocrinology 26P-27P | |
| | 14. | JOHN et al., Journal of Clinical Endocrinology and Metabolism (1999) 84(11):4287-4290 | |
| | 15. | KOHNO et al., J. Clin. Lab. Anal. (1998) 12:268-275 | |
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| | 17. | NUSSBAUM et al., Methods in Enzymology (1985) 109:625-638 | |
| | 18. | RAPLEY et al., Immunology (1993) 78:379-386 | |
| | 19. | TAMPE et al., J. Immunoassay (1992) 13(1):1-13 | |
| | 20. | VIEIRA et al., Brazilian J. Med. Biol. Res. (1987) 20:721-729 | |
| | 21. | VISSER et al., Acta Endocrinology (1979) 90:90-102 | |
| | 22. | Why Nichols is our PTH Vendor, submitted in Defendant's Supplemental Initial Disclosures | |
| | 23. | XIE and ABOU-SAMRA, Endocrinology (1998) 139:4563-4567 | |

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|--------------------|--|-----------------|--|
| Examiner Signature | | Date Considered | |
|--------------------|--|-----------------|--|

sd-265352

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| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i> | | | | Complete if Known | |
| | | | | Application Number | 10/617,489 |
| | | | | Filing Date | July 10, 2003 |
| | | | | First Named Inventor | Thomas L. CANTOR |
| | | | | Art Unit | 1641 |
| | | | | Examiner Name | C. Cheu |
| Sheet | 2 | of | 6 | Attorney Docket Number | 532212000623 |

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|-----|---|--|
| 24. | Subpoena in a Civil Case for Dr. Claude Arnaud, filed May 4, 2005 | |
| 25. | Subpoena in a Civil Case for Dr. Ellen Vitetta, filed May 4, 2005 | |
| 26. | Subpoena in a Civil Case for Joseph O. Falkinham, III, filed May 4, 2005 | |
| 27. | Subpoena in a Civil Case for Gerald Bjorge, filed May 4, 2005 | |
| 28. | Subpoena in a Civil Case for Larry W. Evans, filed May 4, 2005 | |
| 29. | Subpoena in a Civil Case for Dr. Wolf-Georg Forsmann, filed May 4, 2005 | |
| 30. | Subpoena in a Civil Case for Dr. Knut Adermann, filed May 4, 2005 | |
| 31. | Subpoena in a Civil Case for Dr. Dieter Hock, filed May 4, 2005 | |
| 32. | Subpoena in a Civil Case for Dr. Markus Magerlein, filed May 4, 2005 | |
| 33. | Subpoena in a Civil Case for Dr. Thomas Godemeyer, filed May 4, 2005 | |
| 34. | Subpoena in a Civil Case for Dr. Michael Harder, filed May 4, 2005 | |
| 35. | Subpoena in a Civil Case for Dr. Randy Ringold, filed May 4, 2005 | |
| 36. | Subpoena in a Civil Case for Dr. K. Ramakrishnan, filed May 4, 2005 | |
| 37. | Subpoena in a Civil Case for Eva Guthrie, filed May 4, 2005 | |
| 38. | Subpoena in a Civil Case for Julie Lu, filed May 4, 2005 | |
| 39. | Nichols' Opposition to Scantibodies' Motion in Limine No. 1 (That Seeks to Exclude Dr. Hall's Experiments), filed May 5, 2005 | |
| 40. | Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion In Limine No. 2, Nichols' Opposition to Scantibodies Motion In Limine to Exclude Expert Opinion and Other Evidence Regarding Opinion of Counsel, filed May 5, 2005 | |
| 41. | Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion In Limine No. 3 to Preclude Nichols' Reliance on Doctrine of Equivalents, filed May 5, 2005 | |
| 42. | Declaration of Jane Babin in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' In Limine Motion No. 3, filed May 5, 2005 | |
| 43. | Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' In Limine Motion No. 5, Opposition to Scantibodies' Motion to Preclude Evidence of a Hypothetical Negotiation Between Scantibodies and Nichols, filed May 5, 2005 | |
| 44. | Declaration of April Alex in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' In Limine Motion No. 5, filed May 5, 2005 | |
| 45. | Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion In Limine No. 7 to Exclude Evidence Regarding Medicare Billing, filed May 5, 2005 | |
| 46. | Order Granting Nichols Institute Diagnostics Inc.'s Ex Parte Application to Accept Nichols' In Limine Motion No. 21 as Timely Filed, filed May 5, 2005 | |
| 47. | Scantibodies' Opposition to Nichols' Motion in Limine No. 1, filed May 5, 2005 | |
| 48. | Scantibodies' Opposition to Nichols' Motion in Limine No. 2, filed May 5, 2005 | |
| 49. | Scantibodies' Opposition to Nichols' Motion in Limine No. 3, filed May 5, 2005 | |
| 50. | Scantibodies' Opposition to Nichols' Motion in Limine No. 4, filed May 5, 2005 | |
| 51. | Scantibodies' Opposition to Nichols' Motion in Limine No. 5, filed May 5, 2005 | |
| 52. | Scantibodies' Opposition to Nichols' Motion in Limine No. 6, filed May 5, 2005 | |
| 53. | Scantibodies' Opposition to Nichols' Motion in Limine No. 7, filed May 5, 2005 | |
| 54. | Scantibodies' Opposition to Nichols' Motion in Limine No. 8, filed May 5, 2005 | |
| 55. | Scantibodies' Opposition to Nichols' Motion in Limine No. 10, filed May 5, 2005 | |
| 56. | Scantibodies' Opposition to Nichols' Motion in Limine No. 11, filed May 5, 2005 | |
| 57. | Scantibodies' Opposition to Nichols' Motion in Limine No. 13, filed May 5, 2005 | |
| 58. | Scantibodies' Opposition to Nichols' Motion in Limine No. 14, filed May 5, 2005 | |
| 59. | Scantibodies' Opposition to Nichols' Motion in Limine No. 15, filed May 5, 2005 | |
| 60. | Scantibodies' Opposition to Nichols' Motion in Limine No. 16, filed May 5, 2005 | |

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| Examiner Signature | | Date Considered | |
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| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i> | | | | Complete if Known | |
| | | | | Application Number | 10/617,489 |
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| | | | | Examiner Name | C. Cheu |
| Sheet | 3 | of | 6 | Attorney Docket Number | 532212000623 |

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|-----|---|--|
| 61. | Scantibodies' Opposition to Nichols' Motion in Limine No. 17, filed May 5, 2005 | |
| 62. | Scantibodies' Opposition to Nichols' Motion in Limine No. 18, filed May 5, 2005 | |
| 63. | Scantibodies' Opposition to Nichols' Motion in Limine No. 19, filed May 5, 2005 | |
| 64. | Scantibodies' Opposition to Nichols' Motion in Limine No. 20, filed May 5, 2005 | |
| 65. | Stipulation and Notice of Withdrawal Regarding Four Motions In Limine, filed May 5, 2005 | |
| 66. | Supplemental Subpoena in a Civil Case for Ping Gao, filed May 6, 2005 | |
| 67. | Supplemental Subpoena in a Civil Case for Scantibodies Laboratory, Inc., filed May 6, 2005 | |
| 68. | Supplemental Subpoena in a Civil Case for Scantibodies Clinical Laboratory, Inc., filed May 6, 2005 | |
| 69. | Scantibodies' Ex Parte Application Requesting Correction of Order Denying Defendants' Motion For Summary Judgment of Invalidity, filed May 9, 2005 | |
| 70. | Declaration of Katherine L. Parker in Support of Scantibodies' Ex Parte Application Requesting Correction of Order Denying Defendants' Motion For Summary Judgment of Invalidity, filed May 9, 2005 | |
| 71. | [Proposed] Order Granting Scantibodies' Ex Parte Application Requesting Correction of Order Denying Defendants' Motion For Summary Judgment of Invalidity, filed May 9, 2005 | |
| 72. | Transcript of Motion In Limine Hearing/Pretrial Conference, May 9, 2005 | |
| 73. | Transcript of Motions In Limine Hearing, May 10, 2005 | |
| 74. | Transcript of Motions In Limine Hearing, May 11, 2005 | |
| 75. | Scantibodies Clinical Laboratory, Inc., and Scantibodies Laboratory, Inc.'s Second Supplemental Exhibit List, filed May 11, 2005 | |
| 76. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Vivian Shen, filed May 11, 2005 | |
| 77. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Stephen Scheibel, filed May 11, 2005 | |
| 78. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Dr. Richard Lerner, filed May 11, 2005 | |
| 79. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Randolph Wall, Ph.D., filed May 11, 2005 | |
| 80. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Mark Gray, filed May 11, 2005 | |
| 81. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Allen Garrett, filed May 11, 2005 | |
| 82. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Steven Jones, filed May 11, 2005 | |
| 83. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Zan Yang, filed May 11, 2005 | |
| 84. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Thomas G. Wiseman, filed May 11, 2005 | |
| 85. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Damon Cook, filed May 11, 2005 | |
| 86. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Frank Hall, filed May 11, 2005 | |
| 87. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Janet Sharp, filed May 11, 2005 | |
| 88. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Michael Nordstrom, filed May 11, 2005 | |

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| Examiner Signature | | Date Considered | |
|--------------------|--|-----------------|--|

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| | | | | Examiner Name | C. Cheu |
| Sheet | 4 | of | 6 | Attorney Docket Number | 532212000623 |

| | | |
|------|---|--|
| 89. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Thomas Cantor, filed May 11, 2005 | |
| 90. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Dr. J. Stuart Woodhead, filed May 11, 2005 | |
| 91. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Ping Gao, filed May 11, 2005 | |
| 92. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Scantibodies Laboratory, Inc., filed May 11, 2005 | |
| 93. | Objections to Nichols' Subpoena in a Civil Case and Request for Production of Documents to Scantibodies Clinical Laboratory, Inc., filed May 11, 2005 | |
| 94. | Objections to Nichols' Supplemental Subpoena in a Civil Case and Request for Production of Documents to Ping Gao, filed May 11, 2005 | |
| 95. | Objections to Nichols' Supplemental Subpoena in a Civil Case and Request for Production of Documents to Scantibodies Laboratory Inc., filed May 11, 2005 | |
| 96. | Objections to Nichols' Supplemental Subpoena in a Civil Case and Request for Production of Documents to Scantibodies Clinical Laboratory Inc., filed May 11, 2005 | |
| 97. | Stipulation and [Proposed] Order RE Early Access to Courtroom 2 and Set Up of Audio Visual Equipment, filed May 11, 2005 | |
| 98. | Scantibodies' Proposed Voir Dire Questions, filed May 12, 2005 | |
| 99. | Nichols Proposed Voir Dire Questions, filed May 12, 2005 | |
| 100. | Transcript of Status Conference, May 12, 2005 | |
| 101. | Scantibodies' Supplemental Briefing in Support of Scantibodies' Motion in Limine No. 5 RE Timing and Parties to Hypothetical Negotiation, filed May 13, 2005 | |
| 102. | Plaintiff's Memorandum Concerning Freedom of Contract and Retroactivity (In Connection with Defendant's Motion in Limine #5), filed May 13, 2005 | |
| 103. | Nichols' Amended Exhibit List To Memorandum of Fact and Law, filed May 13, 2005 | |
| 104. | Scantibodies' Trial Brief on Inequitable Conduct, filed May 13, 2005 | |
| 105. | Response to Trial Subpoena Request For Production For Claude Araud, M.D., filed May 16, 2005 | |
| 106. | Response to Trial Subpoena Request For Production For Larry W. Evans, filed May 16, 2005 | |
| 107. | Response to Trial Subpoena Request For Production For Gerald H. Bjorge, filed May 16, 2005 | |
| 108. | Response to Trial Subpoena Request For Production For Ellen S. Vitetta, filed May 16, 2005 | |
| 109. | Response to Trial Subpoena Request For Production For Joseph O. Falkinham, filed May 16, 2005 | |
| 110. | Scantibodies Clinical Laboratory, Inc., and Scantibodies Laboratory, Inc.'s Third Supplemental Exhibit List, filed May 16, 2005 | |
| 111. | Notice of Deposition of Allan Garret, filed May 16, 2005 | |
| 112. | Notice of Deposition of Stephen Jones, filed May 16, 2005 | |
| 113. | Notice of Document Discrepancies, Supplemental Exhibit List, filed by Scantibodies, May 17, 2005 | |
| 114. | Notice of Document Discrepancies, Supplemental Briefing, filed by Scantibodies, May 17, 2005 | |
| 115. | Scantibodies' Objections to Nichols' Amended Exhibit List, filed May 17, 2005 | |
| 116. | Bench Trial Transcript – Volume I, May 16, 2005 | |
| 117. | Bench Trial Transcript – Volume II, May 17, 2005 | |
| 118. | Bench Trial Transcript – Volume III, May 18, 2005 | |
| 119. | Bench Trial Transcript – Volume IV, May 19, 2005 | |

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| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i> | | | | Complete if Known | |
| | | | | Application Number | 10/617,489 |
| | | | | Filing Date | July 10, 2003 |
| | | | | First Named Inventor | Thomas L. CANTOR |
| | | | | Art Unit | 1641 |
| | | | | Examiner Name | C. Cheu |
| Sheet | 5 | of | 6 | Attorney Docket Number | 532212000623 |

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| 120. | Bench Trial Transcript – Volume V, May 23, 2005 | |
| 121. | Bench Trial Transcript – Volume VI, May 24, 2005 | |
| 122. | Bench Trial Transcript – Volume VII, May 25, 2005 | |
| 123. | Bench Trial Transcript – Volume VIII, May 27, 2005 | |
| 124. | Order on Motion In Limine Nichols No. 3, filed May 19, 2005 | |
| 125. | Nichols' Objections to Scantibodies' Amended Exhibit Lists, filed May 20, 2005 | |
| 126. | [Proposed] Jury Instructions of Plaintiff Nichols, filed May 25, 2005 | |
| 127. | Nichols Institute Diagnostics, Inc.'s [Proposed] Verdict Form Regarding Infringement and Validity, filed May 25, 2005 | |
| 128. | Nichols Institute Diagnostics, Inc.'s [Proposed] Verdict Form Regarding Damages and Willfulness, filed May 25, 2005 | |
| 129. | Scantibodies' Notice of Motion and Motion for Judgment on Inequitable Conduct and Invalidity, filed May 25, 2005 | |
| 130. | Scantibodies' Memorandum of Points and Authorities in Support of Motion for Judgment on Inequitable Conduct and Invalidity, filed May 25, 2005 | |
| 131. | Declaration of Katherine L. Parker in Support of Scantibodies' Motion for Judgment on Inequitable Conduct and Invalidity, filed May 25, 2005 | |
| 132. | Scantibodies' Proposed Jury Instructions, filed May 25, 2005 | |
| 133. | Scantibodies' Proposed Jury Instructions on Damages and Willfulness, filed May 25, 2005 | |
| 134. | Scantibodies' Proposed Special Verdict Form, filed May 25, 2005 | |
| 135. | Scantibodies' Proposed Special Verdict Form on Damages and Willfulness, filed May 25, 2005 | |
| 136. | Notice of Document Discrepancies, Supplemental Exhibit List filed by Scantibodies, May 26, 2005 | |
| 137. | Scantibodies' Brief Regarding Materiality of Rejection by Foreign Patent Office, filed May 26, 2005 | |
| 138. | Scantibodies' Bench Memorandum Requesting Corrective Jury Instruction, filed May 26, 2005 | |
| 139. | Nichols' Second Amended Exhibit List to Memorandum of Fact and Law, filed May 27, 2005 | |
| 140. | Jury Trial Transcript – Day 1, May 25, 2005 | |
| 141. | Jury Trial Transcript – Day 2, May 26, 2005 | |
| 142. | Jury Trial Transcript – Day 3, May 31, 2005 | |
| 143. | Jury Trial Transcript – Day 4, June 1, 2005 | |
| 144. | Jury Trial Transcript – Day 5, June 2, 2005 | |
| 145. | Jury Trial Transcript – Day 6, June 6, 2005 | |
| 146. | Jury Trial Transcript – Day 7, June 7, 2005 | |
| 147. | Jury Trial Transcript – Day 8, June 8, 2005 | |
| 148. | Jury Trial Transcript – Day 9, June 9, 2005 | |
| 149. | Jury Trial Transcript – Day 10, June 13, 2005 | |
| 150. | Jury Trial Transcript – Day 11, June 14, 2005 | |
| 151. | Jury Trial Transcript – Day 12, June 15, 2005 | |
| 152. | Jury Trial Transcript – Day 13, June 16, 2005 | |
| 153. | Jury Trial Transcript – Day 14, June 20, 2005 | |
| 154. | Jury Trial Transcript – Day 15, June 21, 2005 | |
| 155. | Jury Trial Transcript – Day 16, June 22, 2005 | |
| 156. | Jury Trial Transcript – Day 17, June 23, 2005 | |
| 157. | Jury Trial Transcript – Day 18, June 27, 2005 | |
| 158. | Scantibodies' Proposed Supplemental Jury Instruction Regarding "Idea" of a Patent, filed June 2, 2005 | |

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| | | | | First Named Inventor | Thomas L. CANTOR |
| | | | | Art Unit | 1641 |
| | | | | Examiner Name | C. Cheu |
| Sheet | 6 | of | 6 | Attorney Docket Number | 532212000623 |

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| 159. | Notice of Document Discrepancies, Second Amended Exhibit List, filed by Nichols Institute, June 3, 2005 | |
| 160. | Nichols' Third Amended Exhibit List to Memorandum of Fact and Law, filed June 5, 2005 | |
| 161. | Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Third Amended Exhibit List to Memorandum of Fact and Law, filed June 6, 2005 | |
| 162. | Declaration of April M. Alex in Support of Nichols' Ex Parte Application for Order to File Third Amended Exhibit List to Memorandum of Fact and Law, filed June 6, 2005 | |
| 163. | [Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Its Third Amended Exhibit List to Memorandum of Fact and Law, filed June 6, 2005 | |
| 164. | Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.'s Fourth Supplemental Exhibit List, filed June 6, 2005 | |
| 165. | Scantibodies' Second Proposed Supplemental Jury Instruction (Regarding Inventorship), filed June 8, 2005 | |
| 166. | Scantibodies' Amended Proposed Special Verdict Form, filed June 8, 2005 | |
| 167. | Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its [Proposed] Second Supplemental Jury Instructions of Plaintiff Nichols, filed June 9, 2005 | |
| 168. | Declaration of Joshua G. Gigger in Support of Nichols' Ex Parte Application for Order to File [Proposed] Second Supplemental Jury Instructions of Plaintiff Nichols, filed June 9, 2005 | |
| 169. | [Proposed] Second Supplemental Jury Instructions of Plaintiff Nichols, filed June 9, 2005 | |
| 170. | [Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File [Proposed] Second Supplemental Jury Instructions of Plaintiff Nichols, filed June 9, 2005 | |
| 171. | Deposition of Knut Adermann, Exhibit No. 11 | |
| 172. | Deposition of James T. Carmichael, Exhibit No. 15 | |
| 173. | Deposition of Roger T. Frost, Exhibit No. 18 | |
| 174. | Deposition of Allen Garrett, Exhibit 20 | |
| 175. | Deposition of Allen Garrett Vol. 2, Exhibit No. 21 | |
| 176. | Deposition of Michael Harder, Exhibit No. 23 | |
| 177. | Deposition of Dieter Hock, Exhibit No. 24 | |
| 178. | Deposition of Hartmut H. Malluche, No. 27 | |
| 179. | Deposition of Vivian Shen, Exhibit No. 34 | |
| 180. | Deposition of Ellen S. Vitetta, Exhibit No. 35 | |
| 181. | Judgment Following Court and Jury Trial, Filed June 29, 2005 | |

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

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| Examiner Signature | | Date Considered | |
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